

REMARKS

Claims 40-59 were pending in this application.

Claims 40-59 have been rejected.

Claims 40, 47, and 54 have been amended as shown above.

Claims 40-59 remain pending in this application.

Reconsideration and full allowance of Claims 40-59 are respectfully requested.

I. OBJECTION TO SPECIFICATION

The Office Action objects to the specification as containing inaccurate continuity information. In particular, the Office Action asserts that this patent application does not contain the same disclosure as its parent application, U.S. Patent Application Serial No. 09/032,830. The specification has been amended to recite that this application is a continuation-in-part of its parent application. Accordingly, the Applicant respectfully requests withdrawal of the objection to the specification.

II. OBJECTION TO OATH/DECLARATION

The Office Action objects to the originally filed declaration because this application presents a claim for subject matter not originally claimed or embraced in the statement of the invention (namely, the use of a laser). The representative of the assignee of this application has provided the inventor with copies of the originally-filed application and amendments in this case. The

representative of the assignee is awaiting a signed declaration from the inventor and is prepared to file a Petition Under 37 C.F.R. § 1.47(b) if necessary.

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 54-59 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,976,709 to Sand (“*Sand*”). The Office Action rejects Claims 40-59 under 35 U.S.C. § 102(b) as being anticipated by March et al., “Safety of High-Energy Neodymium:YAG Laser Pulses in YAG Sclerostomy” (“*March*”). These rejections are respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Regarding *Sand*, Claim 54 has been amended to recite “operating [a] laser to irradiate [a] sclera to increase an effective working distance of a ciliary muscle of the eye.” Claim 54 has also been amended to recite “reducing a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.” *Sand* is directed to a method for shrinking collagen to support applications such as corneal reshaping. (*Abstract*). While *Sand* makes various references to the sclera of the eye, the Office Action does not show that *Sand* discloses irradiating the

sclera to “increase an effective working distance of a ciliary muscle of the eye.” The Office Action also does not show that *Sand* discloses “reducing a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.” As a result, the Office Action does not show that *Sand* anticipates all elements of Claim 54 (and its dependent claims).

For these reasons, the Office Action does not show that *Sand* anticipates the Applicant’s invention as recited in Claims 54-59.

Regarding *March*, Claims 40, 47, and 54 have been amended to recite “reducing a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.”

March recites a technique for using laser pulses to form a “new channel for drainage of aqueous humor” in order to treat glaucoma. (*Page 584, Left column, Introduction*). Figure 6 in *March* indicates that a fistula (a new channel) is formed completely through the sclera. In fact, the fistula of *March* must be formed completely through the sclera to allow for the drainage of aqueous humor. Because of this, *March* discloses forming an opening completely through the sclera.

Moreover, it is not obvious to modify *March* to “reduc[e] a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.” *March* is specifically directed at treating glaucoma by forming a drainage fistula, which allows aqueous humor to drain from the anterior chamber of the eye into the subconjunctival space. Aqueous humor could not drain from the anterior chamber of the eye into the subconjunctival space (and therefore glaucoma could not be treated) unless an opening is formed completely through the sclera.

For these reasons, *March* fails to anticipate the Applicant's invention as recited in Claims 40, 47, and 54 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejections and full allowance of Claims 40-59

SUMMARY

The Applicant respectfully submits that all pending claims are in condition for allowance and respectfully requests full allowance of all pending claims.

If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Applicant has submitted the appropriate fee to cover the cost of a one (1) month extension of time. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any additional extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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